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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSHIKI TSUCHIYAMA, SATOSHI ISHIDA,
YASUNORI MIYAUCHI, and SHUUICHI MORIKAWA

Appeal 2010-001762
Application 10/580,211
Technology Center 3600

Before: CHARLES N. GREENHUT, MICHAEL L. HOELTER, and
JAMES P. CALVE, *Administrative Patent Judges.*

GREENHUT, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1-8. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part and denominate our affirmance as a new grounds of rejection pursuant to 37 C.F.R. § 41.50(b).

The claims are directed to an automatic paper feeder. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. An automatic paper feeder supplying paper to an apparatus, comprising:

a separation pad, pressing the paper against a pick roller so as to feed the paper one by one; and

pad pressing means, applying pressure to the separation pad so as to press the separation pad against a surface of the pick roller, the pad pressing means having a reverse U-shape to press the separation pad against the surface of the pick roller at two portions, a front portion and a rear portion, along a rotating direction of the pick roller thereof, and the pad pressing means being configured to be rotatable back and forth with respect to the rotating direction of the pick roller about a fulcrum where pressure is applied to the pad pressing means.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Murayoshi

US 4,674,737

Jun. 23, 1987

REJECTIONS

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Murayoshi.

OPINION

In rejecting claims 1-8 the Examiner relies upon the figure 12 embodiment of Murayoshi. The Examiner cites the figure 3 embodiment of Murayoshi as evidence of how certain features of the figure 12 embodiment operate. Ans. 6. The Examiner does not propose to combine features of the figure 12 embodiment with the figure 3 embodiment. *See* Reply Br. 2.

Appellants raise four issues regarding the Examiner's rejection of claim 1¹: First, Appellants contend Murayoshi's bar 552 is not a "fulcrum." App. Br. 6; *See* Ans. 3. Second, Appellants contend Murayoshi's pressing plate 14, interpreted by the Examiner as the "pad pressing means" (Ans. 3), is not configured to be "rotatable back and forth with respect to the rotating direction of the pick roller" about Murayoshi's bar. App. Br. 7, Reply Br. 2. Third, Appellants contend Murayoshi's bar 552 is not "where pressure is applied to the pad pressing means." App. Br. 7; Reply Br. 3. And, fourth, Appellants contend it was unreasonable for the Examiner to interpret the

¹ We note that claims 1-8 employ means-plus-function language. However, neither the Appellants nor the Examiner provide an analysis of this language under *In re Donaldson Co.* 16 F.3d 1189 (Fed. Cir. 1994) (In order for a prior art element to meet a section 112, paragraph 6 means-plus-function limitation, the prior art element must either be the same as the disclosed structure or be a section 112, paragraph 6 equivalent.) We therefore confine our analysis to the issues raised by Appellants concerning the interpretation of any disputed claim terms. *See* 37 C.F.R. § 41.37(c)(1)(vii) ("Any arguments or authorities not included in the brief or a reply brief will be refused consideration by the Board, unless good cause is shown.").

portions 228, 229 of Murayoshi's pressing plate 14 that join at ridge R2 as forming the claimed "U-shape," because those portions join to form a V-shape. App. Br. 7; Reply Br. 3. Appellants' argument concerning claim 2, pointing out that rotatability must be about a "predetermined position" is an extension of Appellant's second argument. App. Br. 8.

We are persuaded by Appellants' fourth argument that it was unreasonable for the Examiner to interpret the portions 228, 229 of Murayoshi's pressing plate 14 that join at ridge R2 (*See Ans. 7*) as forming the claimed "U-shape." Appellant's Specification has consistently referred to the pad pressing means 3, formed by two parallel portions joined by a third, perpendicular portion, as structure having a "U-shape." Murayoshi refers to the end portion 554 of bracket 550, a structure similar in shape to Appellants' pad pressing means, as in the form of a U. Col. 18, ll. 7-11; fig. 12. This provides additional evidence as to how one of ordinary skill in the art would understand the term. We agree with Appellants that one of ordinary skill in the art would not understand "U-shape" to include two sections joined by a generally sharp angle.

While we are persuaded that the Appellants have demonstrated error in the Examiner's rejection, we agree that the embodiment depicted in figure 3 of Murayoshi still anticipates claims 1 and 2. Support portions 230 of pressing plate 14 form a "reverse U-shape" to press the separation member 13 against the roller 12. Even under this interpretation it remains reasonable to interpret one of the parallel sides of this structure bestriding slot 231 as a "rotating arm," as the Examiner did regarding claim 2. *See Ans. 8.* We agree with the Examiner's remaining findings and analysis concerning claims 1 and 2 and with the Examiner's response to Appellants' first, second

and third arguments. We hereby modify the Examiner’s analysis such that reference to those structures depicted in figure 12 is replaced by reference to the corresponding structure depicted in figure 3, e.g., reference to bar 552 (fig. 12) is replaced by reference to guide shaft 233 (fig. 3). We adopt the Examiner’s response to Appellants’ first three arguments (Ans. 6, 8-9) as our own. We emphasize that Murayoshi’s bar 552/guide shaft 233 supports pressing plate 14 for pivotal, i.e., “rotatable back and forth,” and translational movement towards and away from the separation roller 12. Col. 18, ll. 5-7; col. 7, ll. 40-45. We agree this is sufficient to render it reasonable to interpret Murayoshi’s bar 552/guide shaft 233 as a “fulcrum.” Further, although Appellants have disclosed structures in the Specification for applying a force directly upon the fulcrum 5 to urge it towards or away from the pick roller 1, e.g., spring 4 or rotating arm 7 (Spec. 10 paras. [0041], [0042]), such structures are notably absent from claim 1. Thus, although the “pressure” “applied” by the fulcrum “to the pressing plate” is due to a reactionary force in Murayoshi (*See Ans. 8*), we cannot discern any claim limitations excluding such an arrangement.

Regarding claim 7, the Examiner interprets the bracket 550 supporting the bar 552 as the “pressing unit applying the pressure to the fulcrum of the pad pressing means.” Appellants contend that “the bracket 550 does not serve to apply pressure in Murayoshi’s device.” App. Br. 9. While Appellants appear to contest the Examiner’s position, they have not offered any arguments or evidence to demonstrate why the Examiner erred by determining that, by virtue of its supporting role, bracket 550 applies pressure to bar 552. *See Ans. 9*. Accordingly, we will sustain this rejection based upon the corresponding bracket 19 in the figure 3 embodiment, which

supports guide shaft 233 via upright portions 232². Additionally, in light of the breadth of the pressure applying limitation, as discussed above, we note that Murayoshi's pressure applying arm 15 also meets this limitation.

For the above reasons, we sustain the Examiner's rejection of claims 1, 2 and 7. However, since we have relied upon findings and reasoning different from that of the Examiner, we denominate this affirmation a new grounds of rejection under 37 C.F.R. § 41.50(b) so that Appellants may be afforded a full and fair opportunity to respond.

Each of claims 3-6 and 8 require movement of the fulcrum or the capability therefor. As discussed above, Murayoshi's support portion 230 translates and pivots about guide shaft 233, the structure interpreted as the claimed "fulcrum." Like Appellants (App. Br. 3-9), we can discern no evidence in the portions of Murayoshi cited by the Examiner (*See Ans. 5-6* citing portions of Murayoshi cols. 17-19) indicating that Murayoshi's guide shaft 233 can, or does, move as required by claims 3-6 and 8. Accordingly, we are constrained to reverse the Examiner's rejection of claims 3-6 and 8.

DECISION

We sustain the Examiner's rejection of claims 1, 2 and 7. However, we denominate this affirmation a new grounds of rejection under 37 C.F.R. § 41.50(b).

We reverse the Examiner's rejection of claims 3-6 and 8.

² Note that there appears to be a typographical error in column 7, line 38 of Murayoshi referencing numeral 23 in place of numeral 232.

37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”³⁷ C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmation is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

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